

PATENT

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Applicant(s): David L. Bahr, et al.
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Examiner: George C. Neurauter
Title: SYSTEM AND METHOD FOR SCANNING A DOCUMENT IN
CLIENT/SERVER ENVIRONMENT

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REPLY BRIEF – 37 C.F.R. §41.41

1. Introduction

This Reply Brief is filed pursuant to 37 C.F.R. §41.41 to address the improper Official Notice taken by the Examiner during prosecution and again in the Examiner's Answer. This Reply Brief has been filed within two months of the Examiner's Answer as required by 37 C.F.R. §41.41(a)(1). The Commissioner is hereby authorized to charge the Deposit Account No. 16-0605 for \$250 as required under 37 C.F.R. §41.20(b)(2).

2. Background Regarding the Improper Taking of Official Notice

On several occasions during prosecution, the Examiner has improperly attempted to take Official Notice of facts regarding the functionality and use of toggle buttons, stating with respect to Claims 2 and 23 shown in the Appendix that a software toggle button that alternately generates a start scan signal to scan a document and a send data signal to upload the resulting document data to a server for storage with successive activations of the button was well-known in the art before the date of invention. Not only is this facially implausible, when traversed, the Examiner has not been able to produce any evidence that supports the assertion. This in itself demonstrates that the assertion is not capable of "instant and unquestionable demonstration as

being well-known” as required by M.P.E.P. §2144.03. *Ex Parte Soon-Tae Kim* 2002 WL 1801317, 3 (Bd.Pat.App. & Interf.) (noting that “[i]f the alleged fact or facts is/are so unquestionably demonstrable, the examiner should provide evidence of the truth of his allegation”).

For any viable prospect of establishing Official Notice, the Examiner should have provided documentary evidence or an explicit basis supporting the assertion in the first instance of taking Official Notice. Since he did not, the Official Notice was defective *ab initio*, and Appellant was thus under no obligation to respond to the defective Official Notice. Nonetheless, Applicant has seasonably challenged the taking of Office Notice notwithstanding the Examiner’s assertion that Appellant “failed to traverse anything regarding the Official Notice.” Specifically, the Examiner’s Answer asserts that Appellant failed to challenge or traverse the Official Notice taken in the Office action dated October 13, 2004. The record, however, clearly demonstrates that Appellant has seasonably challenged this and every other taking of Official Notice by the Examiner. It further demonstrates that Appellant has not only addressed each taking of Official Notice, but has traversed each taking as well. Throughout the prosecution of this application over many years, the Examiner has not provided “substantial evidence” comporting with the Administrative Procedure Act (APA) that the toggle buttons or functionality of Claims 2 and 23 *as claimed* was well-known prior to the date of invention. *See, e.g., In re Gartside*, 203 F.3d 1305, 1315, 53 U.S.P.Q.2d 1769, 1775 (Fed. Cir. 2000). Thus, Appellant respectfully requests the Board of Patent Appeals and Interferences (hereinafter “the BPAI”) to reverse the Examiner’s rejection of Claims 2 and 23, and to remand to the Examiner with instructions to issue a Notice of Allowance promptly.

3. Requirements of MPEP §2144.03 Regarding the Taking of Official Notice

Under §2144.03 of the MPEP, Official Notice unsupported by documentary evidence should only be taken if the facts asserted to be well-known “are capable of instant and unquestionable demonstration as being well-known.” If Official Notice is taken without supporting documentary evidence, the applicant must “be presented with the explicit basis on which the examiner regards the matter as subject to Official Notice and be allowed to challenge

the assertion in the next reply” If the Applicant adequately traverses the examiner’s assertion of Official Notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. If applicant does not traverse the examiner’s assertion of Official Notice or applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of Official Notice or that the traverse was inadequate. Furthermore, if the traverse was inadequate, the examiner should include an explanation as its inadequacy.

4. Detailed Explanation of Defects in Official Notice

With regard to this appeal, the Examiner has attempted to take of Official Notice on several occasions without documentary evidence of facts that are not “capable of instant and unquestionable demonstration as being well-known.” Thus, these attempts to take Official Notice have been improper. Furthermore, in all but one instance, the Examiner failed to provide any explicit basis on which he based his assertions. Also, the Examiner generally failed to address the merit of Appellant’s arguments with respect to the Official Notice taken. Instead, the Examiner mechanically repeated his taking of Official Notice that was previously traversed. To demonstrate these facts, each Office action in which relevant Official Notice was taken is addressed in turn.

Office Action of July 8, 2003

In the Office action dated July 8, 2003, the Examiner attempted to take Official Notice “...that a toggle being used as a control element with a user interface is well known and used in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create a control element as claimed.” (Page 11 of the Office action dated July 8, 2003). Thus, the Examiner took Official Notice for the general proposition that toggle buttons are well-known, so therefore, in the Examiner’s view, it does not matter how the claimed toggle button is configured or the specific alternative functions it performs with successive activations, an approach which essentially ignores the limitations of Claims 2 and 23 and those Claims from which they depend. This is a classic example of piecemeal examination in which

the Examiner has attempted to dissect Claims 2 and 23 rather than to consider them “as a whole” as required under 35 U.S.C. 103(a). The rejection was thus improper for this reason. *See Diamond v. Diehr*, 450 U.S. 175, 176 (1981) (noting that claims must be considered as a whole, it being inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis); *Princeton Biochemicals, Inc., Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005) (holding that section 103 specifically requires consideration of the claimed invention as a whole; without this important requirement, an obviousness assessment might successfully break an invention into its component parts and then find a prior art reference corresponding to each component); *Ex Parte Takeshi Yamamori*, 2002 WL 230623, 2 (Bd.Pat.App. & Interf.) (noting that the examiner cannot dissect the claim limitations; rather, they must be considered as a whole).

To the extent that the Examiner was taking Official Notice that the specific toggle button of Claims 2 and 23 that alternately generates a start scan signal to scan a document and a send data signal to upload the resulting document data to a server for storage with successive activations of the button was well-known, this assertion is not capable of instant and unquestionable demonstration as being well-known. Therefore, since this taking of Official Notice did not concern facts capable of instant and unquestionable demonstration as being well-known, the Examiner was required to provide documentary evidence for his conclusion. The Examiner, however, failed to do so. Thus, his taking of Official Notice was defective *ab initio*, and Appellant was not required to respond. Appellant did, however, address the issue in the responsive communication dated October 1, 2003: “Applicant respectfully traverses Official Notice taken in the Office Action to the extent it asserts . . . A control element defined within a browser capable of toggling to control different functions was known to those of ordinary skill in the art at the time the invention was made” (page 34 of the Response dated October 1, 2003). By challenging the Official Notice taken, the Examiner was required to provide documentary evidence to support his conclusion and address Appellant’s challenge in the next Office Action, but he did not. Thus, this taking of Official Notice was not only defective *ab initio*, but traversed by Appellant without the required response from the Examiner.

Office Action of November 7, 2003

In the Office action dated November 7, 2003, the Examiner merely repeated his original taking of Official Notice and again failed to provide documentation in support of his claim: “a toggle being used as a control element within a user interface such as web browser was well known in the art at the time the invention was made,” improperly concluding that the specific toggle buttons or functionality of Claims 2 and 23 were not patentable for this reason. Again, the Examiner’s taking of Official Notice that a control element within a user interface such as a web browser was well-known is improper piecemeal examination, which fails to take into account the specific limitations of Claims 2 and 23 by considering these claims “as a whole” as required by 35 U.S.C. 103(a). *Id.* To the extent that the Examiner was alleging that the specific control elements or functionality of Claims 2 and 23 that alternately generate a start scan signal to scan a document and a send data signal to upload the resulting document data to a server for storage with successive activations of the button were well-known, this allegation is not capable of instant and unquestionable demonstration as being well-known. The Examiner was thus required to provide documentary support for his conclusion. He did not. Thus, this taking of Official Notice was also defective *ab initio* and a response by Appellant was not required. Nonetheless, Appellant did traverse this taking of Official Notice in the responsive communication dated May 7, 2004 (pages 34-35 of the Response dated May 7, 2004). Specifically, Appellant traversed the taking of Official Notice noting that “[t]his toggling of functionality for a control element defined in an HTML document displayed within a web browser, has not been done.” Appellant further traversed the taking of Official Notice on the basis that it failed to consider Claim 23 “as a whole” as required by 35 U.S.C. 103(a).” And lastly, Appellant challenged the Examiner for attempting “to negative the invention by the manner in which it was made, in contravention to 35 U.S.C. 103(a).” These and other arguments were sufficient to challenge and traverse the Examiner’s taking of Official Notice. In the subsequent Office action, the Examiner failed to provide supporting documentation for his assertion and failed to address the merit of Appellant’s arguments. Thus, this taking of Official Notice was not only improper *ab initio*, but traversed without adequate response by the Examiner.

Office Action of October 13, 2004

In the Office action dated October 13, 2004, the Examiner attempted to make his original Official Notice more specific to include “a control element used to alternately generate the start scan signal and the send data signal with respective successive activations of the control element in a user interface was well known in the art at the time the invention was made as a user interface widget known as a ‘toggle button.’” Thus, Applicant’s previous traversals of the Official Notice necessarily apply to this taking Official Notice for this narrower proposition. In this taking of Official Notice, the Examiner did attempt to provide documentary evidence to support his assertion, but the documentation was insufficient to substantiate his claim. Thus, the Official Notice was defective *ab initio* and required no response from the Appellant. Nonetheless, in response, Appellant challenged and traversed this taking of Official Notice in the responsive communications dated February 14, 2005 and March 11, 2005 (pages 40-43 of the Response dated February 14, 2005; pages 40-43 of the Response dated March 11, 2005). Specifically, Appellant noted that the taking of Official Notice was:

respectfully traversed since the bulletin does not provide support for the proposition . . . that toggle buttons for alternately generating a start scan signal to scan a document with a scanner, and a send data signal to send document data and index data to a server over a network for storage, were known to those of ordinary skill in the art as of the filing date of the claimed invention.

Since the bulletins did not adequately support the proposition for which the Examiner took Official Notice, the Examiner was required to provide documentary evidence in the subsequent Office action to support his conclusion, which he did not. Thus again, through these and other arguments, Appellant successfully traversed this taking of Official Notice.

Office Action of April 21, 2005

In the Office action of April 21, 2005, the Examiner merely repeated the taking of Official Notice attempted in the Office action of October 13, 2004: “a control element used to

alternately generate the start and scan signal and the send data signal with respective successive activations of a control element in a user interface was well known in the art at the time the invention was made as a user interface widget known as a “toggle button.” Again, the Examiner failed to provide documentary evidence to support his assertion. Since these assertions are not capable of instant and unquestionable demonstration as being well-known, the Official Notice was defective *ab initio*. Appellant again challenged the Examiner: “the Examiner must produce prior art that discloses a toggle button that has the function of scanning a document and transmitting document data by successive activations” (pages 21-22 of the Response dated July 21, 2005). Moreover, Appellant traversed this taking of Official Notice by pointing out that the Examiner again failed to consider the claim as a whole as required under 35 U.S.C. 103(a). Specifically, the Examiner attempted to take Official Notice of the existence of toggle buttons used for other functions and skewed the appropriate focus for the obviousness analysis. Thus, the Examiner’s taking of Official Notice was again improper *ab initio* and adequately traversed by Appellant without adequate response by the Examiner.

Office Action of August 15, 2005

In the Office action of August 15, 2005, the Examiner incorrectly noted that Appellant “failed to seasonably challenge the Examiner’s assertions.” The Examiner also recycled his taking of Official Notice without providing supporting documentation: “a control element used to alternately generate the start scan signal and the send data signal with respective successive activations of the control element in a user interface was well known in the art . . . as a user interface widget known as a ‘toggle button’ . . . [making it obvious] to modify the teachings of Quillix” Although the Examiner did cite Vock et al. on the record, he did not cite it to support the scope of this particular taking of Official Notice. Thus, his assertion was not only incorrect, but the taking of Official Notice was again defective *ab initio*. At that time, Appellant had not only seasonably challenged each taking of Official Notice, but traversed each one as well. Appellant’s Pre-Appeal Brief dated September 28, 2005, however, again addressed the taking of Official Notice (pages 4-5 of the Pre-Appeal Brief dated September 28, 2005). In the Pre-Appeal Brief, Appellant noted that the “Examiner has taken Official notice of numerous matters . . . and has failed to provide evidence to support the assertions after timely traversal of

the taking of Official notice” Additionally, Appellant noted that the “Examiner has attempted to abstract the claimed elements outside of the context of the claimed invention in an effort to assert that such elements are well-known by taking Official notice.” This dissection of claim language, as previously noted, has been held improper by numerous BPAI and Federal Circuit decisions. Thus, even though a response to the Examiner’s improper taking of Official Notice was not required, Appellant challenged and traversed it. Furthermore, in the subsequent Office action, the Examiner again failed to address the merit of Appellant’s arguments and further failed to produce documentation to support his assertions made in the previous Office action.

Office Action of November 17, 2005

In the Office action of November 17, 2005, the Examiner again repeated the Official Notice addressed in Appellant’s Pre-Appeal Brief dated September 28, 2005. As noted, by this time Appellant had decided to appeal. Thus, Appellant challenged this taking of Official notice in Appellant’s Appeal Brief dated April 17, 2006: “Appellant has repeatedly traversed this assertion because there is no motivation in the prior art that would have led one of ordinary skill in the art to modify toggle buttons to alternately generate start scan and send data signals” (pages 26-27 of Appeal Brief dated April 17, 2006). Appellant further noted that the Examiner has failed to consider the claim as a whole and failed to produce prior art disclosing a toggle button functional to scan a document and transmit document data by successive activations. In response, the Examiner’s Answer states that Appellant has failed to seasonably challenge the Examiner’s taking of Official Notice in the Office action dated October 13, 2004. This is incorrect. The record clearly demonstrates that Appellant has addressed and traversed each taking of Official Notice in a timely manner. It further demonstrates that the Examiner has continuously recycled his taking of Official Notice without providing any documentary evidence or explicit reasoning to support his assertions. The Examiner’s Answer also states that the Examiner provided U.S. Patent 6,266,623 to Vock et al. as a reference showing the claimed control element. This reference, however, was not provided until the Office action of August 15, 2005. Moreover, it was not provided to support the assertion that “a control element used to alternately generate the start scan signal and the send data signal with respective

successive activations” is known in the art as a toggle button. Thus, the Examiner did not provide any documentation to support his taking of Official Notice. Therefore, the Examiner’s assertions not only are incorrect, but the taking of Official Notice was again defective *ab initio*.

Taking of Official Notice in Examiner’s Answer

The Examiner has attempted to take Official Notice in the Examiner’s Answer, again unsupported by documentary evidence or substantive explanation. Appellant submits that the Examiner may not take Official Notice on appeal since the record is closed at this point. In any case, for the reasons repeated numerous times on this record and in this Reply Brief, Appellant notes the Examiner’s taking of Official Notice was defective *ab initio*, that taking of Official Notice has been traversed time and time again, and that the Applicant does hereby traverse the taking of Official Notice yet again with respect to the Examiner’s Answer. Further, the Examiner has failed to provide an adequate response to the traversal, namely, a prior art reference showing what the Examiner asserts to be well-known. Given that the prosecution of this application has extended over many years, with many opportunities for the Examiner to search the prior art to produce a reference substantiating the Examiner’s Official Notice, one can only assume that that prior art reference does not exist. Allowance of Claims 2 and 23 is therefore appropriate.

5. Summary

Each taking of the Official Notice by the Examiner was defective *ab initio*. Under Section 2144.03 of the MPEP, “official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted . . . are capable of instant and unquestionable demonstration as being well-known.” The allegations in this case are not capable of such proof. Thus, the Examiner improperly attempted to take Official Notice by not providing documentary evidence to support his allegations. Even *assuming* the facts were capable of instant and unquestionable demonstration as being well-known, the Examiner would have been required to set forth the basis of his reasoning explicitly. The Examiner failed to do this; rather, he attempted to rely on general assertions that his claims were true. Moreover, Appellant challenged and traversed each taking of Official Notice. After Appellant responded to each

taking of Official Notice, the Examiner failed to either provide documentation to support his taking of Official Notice or to explain why Appellant's traversal was inadequate. Thus, each taking of Official Notice by the Examiner was defective *ab initio* and timely traversed by Appellant without adequate response from the Examiner.

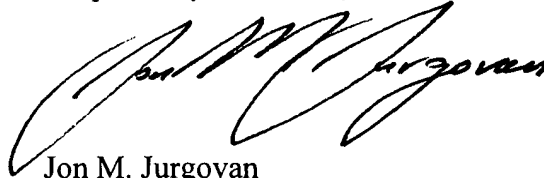
Appellant is entitled to a patent unless the examiner can prove otherwise. 35 U.S.C. §102. Moreover, it is fundamental to Due Process that Appellant cannot be denied a valuable patent right without "substantial evidence" supporting a rejection. *In re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000) (noting that the Board's opinion must explain its factual conclusions, enabling verification as to whether the conclusions are indeed supported by "substantial evidence" contained within the record). A rejection under 103 based solely on the Examiner's notion as to what he thinks is prior art is insufficient to deny Appellant valuable property rights in the present invention, especially where the Examiner has been provided every opportunity to provide supportive evidence over the six-year period of prosecution of this application and has not been able to do so. *Ex Parte Soon-Tae Kim* 2002 WL 1801317, 3 (Bd.Pat.App. & Interf.) (noting that the examiner failed to present any evidence, preferring, instead, to merely allege, that the examiner may take Official Notice of facts capable of instant and unquestionable demonstration; the court, however, stated that "[i]f the alleged fact or facts is/are so unquestionably demonstrable, the examiner should provide evidence of the truth of his allegation").

For the foregoing reasons, Appellant requests the BPAI to reverse the rejection of Claims 2 and 23 be reverse Examiner be overturned and submits that the claims are in condition for allowance. The BPAI is respectfully requested to enter a Notice of Allowance itself or reverse and remand to the Examiner with instructions to promptly issue a Notice of Allowance without further delay.

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Appendix Showing Claims 2 and 23 and the Claims from which they depend

1. A method comprising the step of:

a) **generating a display based on a hypertext mark-up language (HTML) document stored in a client device using a web browser of a user interface of the client device, the display including a document display portion, an index field portion, and a control portion all visibly defined in the display in separate portions thereof by the HTML document, the document display portion including a display of document data received from a scanner coupled to the client device, the scanner generating the document data by scanning a document in print form, the document data representing the scanned document, the index field portion permitting index data to be input by a user with an input device of the client device into the user interface in association with the document data, and the control portion including at least one control element operable by the user with the input device for generating a start scan signal to initiate scanning of the document with the scanner to generate the document data and for generating a send data signal to transmit the document data with the index data displayed by the web browser from the client device to the server over a network using a destination address for the server specified in an address field of the web browser.**

2. A method as claimed in claim 1, **wherein the control element is operable by the user with the input device to alternately generate the start scan signal and the send data signal with respective successive activations of the control element with the input device.**

9. (previously presented): A method comprising the steps of:

a) **generating at a client device a start scan signal using a control element defined by a hypertext mark-up language (HTML) document stored in the client device and displayed by a web browser of a user interface of the client device in response to a user's operation of an input device of the client device;**

b) at the client device, converting the start scan signal into a form compatible with a scanner;

c) at the client device, transmitting the converted start scan signal from the client device to the scanner;

d) receiving the converted start scan signal at the scanner; and

e) scanning a document with the scanner to generate document data, in response to the converted start scan signal received in said step (d).

11. (previously presented) A method as claimed in claim 9, further comprising the steps of:

f) transmitting the document data from the scanner to the client device;

g) receiving the document data at the client device;

h) at the client device, converting the document data into a form that can be displayed within the web browser of the client device; and

i) generating a display including the scanned document on the web browser of the client device, based on the document data converted in step (h).

12. (previously presented) A method as claimed in claim 11, further comprising the step of:

j) adjusting the display of the document data via a user's operation of a control element defined by the HTML document displayed by the web browser within the user interface.

20. A method as claimed in claim 12, further comprising the steps of:

k) user inputting predetermined index data into an index field defined by the HTML document separately from a document display portion in which the document data from the scanner is displayed by the web browser of the user interface of the client device;

l) generating a send data signal using the control element operated by a user with the input device and defined by the HTML document displayed by the web browser of the user interface of the client device;

m) transmitting the document data and index data from the client device to the server over an internetwork in response to the send data signal generated in said step (l);

n) receiving the document data and index data at the server; and

o) storing the document data in association with the index data in a database of a data storage unit separate from the server.

23. A method as claimed in claim 20, **wherein the start scan signal and the send data signal are input by the user with the input device via a common control element displayed within the web browser of the user interface that toggles between a first scan mode for the performance of said step (a) and a second send mode for the performance of said step (m).**